<u>REMARKS</u>

This application has been carefully reviewed in light of the Office Action dated December 20, 2001. Claims 1, 4 to 6, 8 to 16, 19 to 21, and 23 to 35 remain in the application. Claims 1, 16 and 30 to 35, the independent claims herein, have been amended. Reconsideration and further examination are respectfully requested.

Claim 32 was objected to for informalities. Claim 32 has been amended to include a semi-colon after "apparatuses" at line 8, but the comma at the end of the claim (as last filed) has not been changed. In this regard, Claim 32, as last filed, inadvertently omitted the wherein clause, which has now been included as shown in the amended Claim 32. Withdrawal of the objection is respectfully requested.

Claim 32 was rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,287,194 (Lobiondo). In this regard, Claim 32, as last filed, inadvertently omitted the wherein clause which is included in the other independent claims. In light of the amendment to Claim 32 to include the wherein clause as contained in the other independent claims, and the Office Action's admission that the other independent claims are not anticipated by Lobiondo, amended Claim 32 is clearly not anticipated and therefore, withdrawal of the § 102 rejection is respectfully requested.

Claims 1, 4, 5, 8, 12 to 16, 19, 20, 23, 27 to 31 and 33 to 35 were rejected under 35 U.S.C. § 103(a) over Lobiondo in view of U.S. Patent No. 5,187,750 (Behera), Claims 6 and 21 were rejected under § 103 over Lobiondo in view of Behera and further in view of U.S. Patent No. 6,088,120 (Shibusawa), Claims 9 and 24 were rejected under § 103 over Lobiondo in view of Behera and further in view of U.S. Patent No. 5,859,711 (Barry), and Claims 10, 11, 25 and 26 were rejected under § 103 over Lobiondo in view of

Behera and further in view of U.S. Patent No. 5,467,434 (Hower). Reconsideration and withdrawal of the rejections are respectfully requested.

The present invention concerns selecting an image output apparatus from among a plurality of image output apparatuses. According to the invention, when an operator designates to select an image output apparatus which completes execution of an image output job in a shortest time, an image output apparatus is selected from among the plurality of image output apparatuses which can perform an output operation in the shortest time based on data for each of the respective image output apparatuses which indicates a time required by each of the image output apparatuses to output one page of an output job, and a number of pages for output jobs assigned to each of the image output apparatuses which have not yet been output. For example, a query may be performed to obtain data indicating the time required for each of the apparatuses to print one page and to determine how many pages of output jobs have been assigned to each apparatus, but which have not yet been printed. As a result, an apparatus that has the best combination of time for printing one page and the least number of pages pending to be printed can be selected to output a job in the shortest time.

Referring specifically to the claims, amended independent Claim 1 is a data processing apparatus having connection means for being connected to a plurality of image output apparatuses, comprising first obtaining means for obtaining first data associated with an image output job, the first data being designated by an operator, second obtaining means for obtaining second data associated with each of the plurality of image output apparatuses, selection means for selecting an image output apparatus, based on the first data and the second data, from the plurality of image output apparatuses, and job assigning

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means for assigning the image output job to the image output apparatus selected by the selection means, wherein, in a case where the first data designated by the operator designates to select an image output apparatus which completes execution of the image output job in a shortest time, the selection means selects an image output apparatus from among the plurality of image output apparatuses which can perform an output operation in the shortest time based on second data for each of the respective image output apparatuses which indicates a time required by each of the image output apparatuses to output one page of an output job, and a number of pages for output jobs assigned to each of the image output apparatuses which have not yet been output.

Amended independent Claims 16, 32 and 33 are method, memory medium and program claims, respectively, that substantially correspond to Claim 1.

Amended independent Claims 30, 31, 34 and 35 are along the lines of Claims 1, 16, 32 and 33, respectively, with one difference being the omission of the assigning means/step.

The applied art, alone or in any permissible combination, is not seen to disclose or to suggest the features of independent Claims 1, 16 and 30 to 35. In particular, the applied art is not seen to disclose or to suggest at least the feature of, where an operator designates to select an image output apparatus from among a plurality of image output apparatuses which completes execution of an image output job in a shortest time, an image output apparatus is selected from among the plurality of image output apparatuses which can perform an output operation in the shortest time based on second data for each of the respective image output apparatuses which indicates a time required by each of the image

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output apparatuses to output one page of an output job, and a number of pages for output jobs assigned to each of the image output apparatuses which have not yet been output.

The Office Action admits that Lobiondo fails to teach the foregoing features, but cites Behera's column 13, lines 4 and 15 to 30 as allegedly making up for the foregoing deficiencies.

Behera is seen to disclose a system for printing monthly banking statements. The patent describes various situations that each provide a description of the time required to print a certain number of pages. For example, as described at column 13, lines 15 to 30, if 18,000 accounts each have 3 pages to be printed, the total number of pages to be printed would be 54,000. Assuming that only "one" printer can print 90 pages per minute, the total time to print the 54,000 pages by one printer would be 12.5 hours. The time to print the same 54,000 pages by two printers would be, of course, reduced by half to 6.25 hours. The time to print the same 54,000 pages by three printers would be, of course, 4.16 hours, while the time to print the same 54,000 pages by four printers would be, of course, 3.125 hours. Thus, Behera merely teaches that it would take less time to print the same number of pages by spreading the printing operation out among multiple printers. Nowhere, however, does Behera teach selecting one of the plurality of printers based on data indicative of a time required by each of the image output apparatuses to output one page of an output job, and a number of pages for output jobs assigned to each of the image output apparatuses which have not yet been output.

In view of the foregoing deficiencies of Lobiondo and Behera, independent Claims 1, 16 and 30 to 35 are believed to allowable.

The other applied art, namely Shibusawa, Barry and Hower, have been studied but are not seen to add anything to overcome the deficiencies of Lobiondo and Behera. More particularly, none of Shibusawa, Barry and Hower are seen to disclose or to suggest at least the feature of, where an operator designates to select an image output apparatus from among a plurality of image output apparatuses which completes execution of an image output job in a shortest time, an image output apparatus is selected from among the plurality of image output apparatuses which can perform an output operation in the shortest time based on second data for each of the respective image output apparatuses which indicates a time required by each of the image output apparatuses to output one page of an output job, and a number of pages for output jobs assigned to each of the image output apparatuses which have not yet been output. Therefore, all of Claims 1, 4 to 6, 8 to 16, 19 to 21, and 23 to 35 are believed to be allowable over the applied art.

Moreover, it is Applicant's position that the Office Action fails to set forth a prima facie case of obviousness. According to MPEP § 2143.01: "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (In re Fine, 837 F.2d 1071 (Fed. Cir. 1988); In re Jones, 958 F.2d 347 (Fed. Cir. 1992))."

In the present situation, Behera relates to printing of bank statements in which the total time to print the statements can be reduced by spreading the printing of the statements out among a plurality of printers. Behera, however, fails to teach anything relating to selecting one of a plurality of printers so as to print in the shortest time, where

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the printer is selected based on the time to print one page and the number of pages assigned to the printer, but not yet printed. As such, there is nothing in Behera that would have lent itself to resolving the problems associated with selecting one printer from among a plurality of printers so as to print in a shortest time. Accordingly, there is no motivation or suggestion to combine Lobiondo with Behera. As such, the Office Action fails to make out a prima facie case of obviousness and the rejection is believed to be improper.
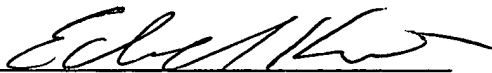
Additionally, the Federal Circuit has recently elaborated on the Patent Office's burden regarding motivation or suggestion to combine references when rejecting claims for obviousness. In In Re Sang Su Lee, Docket No. 00-1158, decided January 18, 2002 (copy attached as Exhibit A), the Federal Circuit held that the Patent Office cannot merely rely on conclusory statements that it is common knowledge in the art that particular references can be combined, but must provide objective factual evidence of a motivation to combine in order to meet their obligation for negating patentability based on obviousness. In the present case, the Office Action states that "it would have been obvious to ... [modify] Lobiondo by the teaching of Behera because ... it would have allowed the printing system to accurately predict which image output apparatus that can print the print job in the shortest time." However, Applicant respectfully points out that Behera merely teaches that a print job can be printed in less time by spreading the print job out amongst multiple printers and contrary to the Office Action's assertion, nothing in Behera teaches predicting which of the printers can print in the shortest time, much less selecting a printer based on a time to print one page and a number of pages assigned to the printer but not yet printed. Accordingly, Applicant submits that the Office Action fails to meet the required burden and even if each of the individual references disclose all that the Office Action alleges, the

Examiner must nonetheless provide objective factual evidence that one skilled in the art would have been motivated to combine the references at the time of the invention. It is particularly requested that the Examiner provide objective factual evidence of how one skilled in the art would have been motivated to combine the five separate references cited in the Office Action in order render the claims obvious. Accordingly, the Examiner is respectfully requested to reconsider the rejection in light of the In Re Sang Su Lee decision and, if the basis of the rejection is maintained, then the Examiner is requested to provide the necessary evidence to meet the burden required by law.

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

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